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PATENT APPLICATION

ATTORNEY DOCKET NO. 200608970-1

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 17 2006

Inventor(s): Gregory J. May

Confirmation No.: 9102

Application No.: 10/628,947

Examiner: Blackman, R. A.

Filing Date: 07/28/2003

Group Art Unit: 2851

Title: PROJECTION SYSTEM

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 11/14/2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$120.00
() two months	\$450.00
() three months	\$1020.00
() four months	\$1590.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Number of pages: 13

Typed Name: Kathryn L. Nash

Signature: Kathryn L. Nash

Respectfully submitted,

Gregory J. May

By Glenn E. Forbis

Glenn E. Forbis

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Reg. No. 40,610

Date: 01/17/2006

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Dated: January 17, 2006

Signature:


(Kathryn L. Nash)**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:
Gregory J. May

Application No.: 10/628,947

Art Unit: 2851

Filed: July 28, 2003

Examiner: R. A. J. Blackman

For: PROJECTION SYSTEM**APPEAL BRIEF**

MS Appeal Brief -- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This brief is submitted pursuant to the appeal of the final rejection of claims 1, 2, and 4-35 dated June 14, 2005 and the Examiner's Advisory Action dated September 27, 2005.

I. REAL PARTY IN INTEREST

The Real Party-In-Interest is Hewlett-Packard Co., a Delaware corporation. The assignee is Hewlett-Packard Development company, a Texas Limited Partnership, which is wholly owned by Hewlett-Packard Co."

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeal or interference.

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III. STATUS OF CLAIMS

Claims 1, 2 and 4-35 are pending. Claim 35 has been allowed. Of the remaining claims, claim 1, 21 and 33 are independent claims. Dependent claims 9, 19 and 20 are the subject of this appeal. In the Final Office Action, the Examiner rejected claim 9 under 35 U.S.C. §102 in light of United States Patent No. 5,739,875 to Toide et al. ("Toide"), and the Examiner rejected claims 19 and 20 under 35 U.S.C. §103 in light of Toide in view of United States Patent No. 6,483,568 to Follo ("Follo").

IV. STATUS OF AMENDMENTS

Appellant submitted an Amendment In Response To Final Office Action on August 15, 2005, wherein Appellant proposed amendments that would convert dependent claims 9 and 19 into independent claims and wherein Appellant pointed out the deficiencies in the Examiner's rejection of claims 9 and 19 based upon the prior art of record. The proposed amendment also corrected an informality in claim 9 that formed the basis for an objection to claim 9 by the Examiner.

The Examiner mailed an Advisory Action on September 27, 2005, refusing to enter the new amendments on the basis that they allegedly "raise new issues that would require further consideration and/or search." Appellant spoke with the Examiner in October 2005 and pointed out that the amendments proposed in Appellant's Response To Final Office Action did not modify the scope of the claims; rather, they merely incorporated limitations of existing claims into independent claims, in effect to make claims 9 and 19 independent. The Examiner maintained her Advisory Action

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position and refused to enter the proposed amended claims. Hence, claims 9, 19 and 20 as they existed at the time of the Final Office Action are at issue in this appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 1

A video and audio projection system is provided. The projection system includes a projection device (Fig. 1, #10; Paragraph [10]) and a secondary signal transmitter (Fig. 1, #12; Paragraph [10]). The projection device is configured to project visible video images, such as still images and/or video images, onto a screen (Fig. 1 #14; Paragraph [10]). The secondary signal transmitter projects invisible light signals onto the screen ([Paragraph [10]). The invisible light signals carry secondary information associated with the visible video images, such as a soundtrack associated with a movie (Paragraph [10]). The invisible light signals reflect from the screen and are received and decoded by one or more receivers (Fig. 1, # 16a, 16b; Paragraph [10]).

B. Dependent Claims 8 and 9

The projection system generates a plurality of channels of invisible light signals and the receivers are configured to be able to be selectively adjusted to receive and decode a selected subset of the plurality of channels of invisible light. (Paragraph [13]). The invisible light signals carry audio information and the receivers are configured to decode the invisible light signals into audibly-perceptible sounds. (Paragraph [10]). The multiple channels of invisible light signals could be used for a variety of purposes, including, for example, wherein each channel of invisible light carries different versions (e.g., different languages) of the same soundtrack. (Paragraph [13]).

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C. Dependent Claim 19

The projection device includes a digital micromirror device (Fig. 2A, #24; Paragraph [16]) having a plurality of micromirrors that each selectively reflects light from a primary light source (Fig. 2A, #20; Paragraph [17]) through a lens (Fig. 2A, #26; Paragraph [17]). The secondary signal transmitter (Fig. 2A, #12, Paragraph [18]) is positioned inside of the projection device and is configured to emit the invisible light signal such that it is reflected by a plurality of the micromirrors concurrently with light from the primary light source through the lens.

D. Dependent Claim 20

The projection device includes a digital micromirror device (Fig. 2B, #24; Paragraph [16]) having a plurality of micromirrors that each selectively reflects light from a primary light source (Fig. 2B, #20; Paragraph [17]) through a lens (Fig. 2B, #26; Paragraph [17]). The secondary signal transmitter (Fig. 2B, #12, Paragraph [18]) is positioned inside of the projection device. The invisible light signal is reflected by each of the micromirrors through the lens at times when light from the primary light source is not reflected through the lens by the respective micromirror. (Paragraph [18]).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claim 9 is patentable under 35 U.S.C. §102.
2. Whether claims 19 and 20 are patentable under 35 U.S.C. §103.

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VII. ARGUMENT

A. Claim 9 Is Patentable Under 35 U.S.C. §102.

The Examiner finally rejected claim 9 under 35 U.S.C. §102 in view of Toide.

Claim 9 depends from claims 1 and 8. The Examiner's final rejection of claim 9 should be reversed because Toide does not disclose all of the elements of claim 9.

Claim 1 recites:

1. A projection system, comprising:

a projection device configured to project visible video images onto a screen;

a secondary signal transmitter configured to project invisible light signals onto said screen, said invisible light signals being reflected off of said screen to one or more receivers configured to receive and decode said reflected invisible light signals; and

wherein said invisible light signals are encoded to represent secondary information associated with said video.

Claim 8 adds that the secondary signal transmitter transmits a "plurality of channels":

8. The system of claim 1, wherein said secondary signal transmitter is configured to project a plurality of channels of invisible light signals onto said screen.

Finally, claim 9 adds one or more receivers configured to selectively receive and decode one of the plurality of channels of invisible light:

9. The system of claim 8, further comprising one or more receivers configured to receive said invisible light signals projected onto said screen and to decode said invisible light signals into audibly-perceptible sounds; and wherein said receivers are equipped to be selectively configured by a user to decode one of said plurality of channels of invisible light signals into audibly-perceptible sounds at a given time.

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Thus, claim 9 recites a projection system where a *plurality of channels* of invisible light signals are projected and one or more receivers are configured to selectively receive and decode *one* of the plurality of channels of invisible light. While this type of system has many uses, one exemplary use is to project multiple versions of the same soundtrack (e.g., in different languages) and to permit users to adjust their personal headphones (receivers) so as to listen to the soundtrack in the language of their choice.

The Examiner relied upon col. 21 lines 16-20 of Toide in rejecting claim 9 under 35 U.S.C. §102. Appellant respectfully submits that Toide does not disclose or suggest receivers that are configured to be selectively adjusted to receive and decode *one* of a *plurality of channels* of invisible light signals. Toide simply makes no mention of such a feature. In particular, lines 16-20 of column 21 state:

FIG. 35 is a structural diagram of the light receiver 34. The light receiver 34 is built in the headphone 31, and the received light signal is photoelectrically converted by a photo detector 43, and is demodulated to a specified audio signal by a demodulation circuit 44.

There is no mention of the features recited in claim 9 in lines 16-20 of column 21, or, as discernable by Appellant, anywhere else in Toide. Therefore, Appellant respectfully submits that the Examiner has not set forth adequate reasons to reject claim 9 under 35 U.S.C. §102. The Examiner's rejection of claim 9 should be reversed.

B. CLAIMS 19 AND 20 ARE PATENTABLE UNDER 35 U.S.C. §103.

The Examiner rejected dependent claims 19 and 20 under 35 U.S.C. §103 in light of Toide and U.S. Patent No. 6,811,267 to Allen. The Examiner's rejection of these claims under §103 should be reversed because the Allen patent is not proper prior art under §103(c).

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35 U.S.C. §103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The Allen patent issued on November 2, 2004, whereas the pending application was filed on July 28, 2003. Accordingly, the Allen patent would qualify, if at all, as §102(e)-type prior art. Both the Allen patent and the current pending application are assigned to the Hewlett-Packard Development Company, L.P., and at the time of the invention of the present application, the Allen patent and the present invention (resulting in the instant application) were owned by and/or subject to an obligation to assign to the Hewlett-Packard Development Company, L.P. Therefore, the Allen patent cannot be used to preclude patentability of the current pending application under §103.

In Appellant's Amendment in Response to Final Office Action (filed on August 15, 2005), Appellant's attorney set forth a statement to the effect that the Allen patent and the instant application were both assigned to and/or obligated to be assigned to the Hewlett-Packard Development Company, L.P. at the time of invention of the instant application. Therein, Appellant also inadvertently made reference to a declaration of Gregory May (the inventor), which did not accompany Appellant's Amendment in Response to Final Office Action.¹ The Examiner cited in the Advisory Action the lack of a declaration from Mr. May as the basis for maintaining her rejection under §103.

¹ In an early draft of the Response, Appellant intended to include a declaration of inventor Gregory May to support the fact that he was under obligation to assign the instant application to the Hewlett-Packard Development Company at the time of invention. However, based upon a subsequent review of the MPEP indicating that such a declaration

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However, the MPEP makes clear that a declaration from the inventor is not necessary to establish that he was under an obligation to assign:

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organization:

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

MPEP 706.02(l)(2).

Therefore, Appellant respectfully submits that the Examiner has not established a prima facie case of obviousness under §103 because the Allen reference is not proper prior art under §103.

VIII. CONCLUSION

In view of the foregoing arguments, Appellant respectfully submits that the pending claims 9, 19 and 20 are patentable under 35 U.S.C. §§102 and 103. The Examiner's rejection of these claims is improper because the proper prior art of record does not teach or suggest each and every element of the claimed invention. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

Any fees associated with the filing of this paper should be identified in any accompanying transmittal. Please charge Deposit Account No. 08-2025, under Order No. 200308970-1 from which the undersigned is authorized to draw.

was not necessary, Appellant decided to rely upon the statement of the attorney of record, as permitted by the MPEP.

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Dated: January 17, 2006

Respectfully submitted,

By 

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APPENDIX A – CLAIMS ON APPEAL

1. A projection system, comprising:

a projection device configured to project visible video images onto a screen;

a secondary signal transmitter configured to project invisible light signals onto said screen, said invisible light signals being reflected off of said screen to one or more receivers configured to receive and decode said reflected invisible light signals; and

wherein said invisible light signals are encoded to represent secondary information associated with said video.

8. The system of claim 1, wherein said secondary signal transmitter is configured to project a plurality of channels of invisible light signals onto said screen.

9. The system of claim 8, further comprising one or more receivers configured to receive said invisible light signals projected onto said screen and to decode said invisible light signals into audibly-perceptible sounds; and wherein said receivers are equipped to be selectively configured by a user to decode one of said plurality of channels of invisible light signals into audibly-perceptible sounds at a given time.

19. The system of claim 1, wherein said video projection device includes a digital micromirror device having a plurality of micromirrors that each selectively reflects light from a primary light source through a lens; and wherein said secondary signal transmitter is positioned inside of said video projection device and is configured to emit

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said invisible light signal such that it is reflected by a plurality of said micromirrors concurrently with light from said primary light source through said lens.

20. The system of claim 1, wherein said video projection device includes a digital micromirror device having a plurality of micromirrors that each selectively reflects light from a primary light source through a lens; and wherein said secondary signal transmitter is positioned inside of said video projection device and is configured to emit said invisible light signal such that it is reflected by each of said micromirrors through said lens at times when light from said primary light source is not reflected through said lens by said respective micromirror.